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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,516	10/15/2003	Peter A. R. Bennett	HOR-16REISSUE (EKC 90372)	6722

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EXAMINER	
LEE, SIN J	

ART UNIT	PAPER NUMBER
1795	

MAIL DATE	DELIVERY MODE
04/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/686,516	BENNETT ET AL.	
	Examiner	Art Unit	
	Sin J. Lee	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *26 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-35,37-51,53,54,56,58-61 and 63-65* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *25-35* is/are allowed.

6)☒ Claim(s) *1,2,4-12,14-19,24,37-51,53,54,56,58-61,63 and 65* is/are rejected.

7)☒ Claim(s) *13,20-23 and 64* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/194,822.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 4, 6-12, 14-16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Fan et al (5,654,125), Sulzberg (4,173,554) and Fitzgerald et al (5,607,816).

Yamaoka teaches a photopolymerizable composition having a high sensitivity to *visible* and *near infrared light* at a wavelength of *600 nm or more* (col.1, lines 17-21). The photopolymerizable composition comprises (see col.4, lines 50-55), an addition-polymerizable compound, which has at least one ethylenically unsaturated double bond, a radical generating agent and squarylium compound (*present infrared-absorbing dye*).

According to col.7, lines 17-25, Yamaoka's addition-polymerizable compound can either be a monomer (such as esters of unsaturated carboxylic acid and an aliphatic polyhydroxy compound as listed in col.7, lines 38-54) or a polymer having an ethylenically unsaturated double bond on the main or side chain (such as polymers obtained by a polymeric reaction of a polyvinyl alcohol, an epoxy resin, a phenoxy resin or the like with an unsaturated carboxylic acid – see col.8, lines 31-37) so that upon irradiation of an active ray to the photopolymerizable composition, the ethylenical compound cures due to addition-polymerization by the action of the radical-producing agent and the photodecomposition product of the squarylium compound. Thus, Yamaoka teaches present radiation sensitive resin. Yamaoka also teaches (col.7, lines 5-15, col.12, lines 66-67, col.13, line 1) that his composition can also contain a binder polymer such as poly(meth)acrylic esters as well as a colorant (a dyeing pigment). Yamaoka states (col.14, lines 18-20, lines 34-40) that his photopolymerizable composition can be used for making *printing plates* and that his composition is coated onto a base such as an aluminum sheet which surface is treated by graining and anodic oxidation processing (thus, Yamaoka teaches *present lithographic support having a hydrophilic surface*). The coated layer is then is subjected to irradiation of light, and the irradiation source includes *visible and near infrared lasers* (col.14, lines 28-33 and lines 45-47). Then the unexposed portions of the photosensitive sample are removed with a developer (such as *aqueous solutions* of an organic alkali chemicals) to provide a printing plate (col.14, lines 32-33, lines 48-49, lines 54-55).

Therefore, Yamaoka teaches present invention of claim 1 (it is the Examiner's position that Yamaoka's photopolymerizable composition containing *colorant* compound teaches present radiation sensitive ink) except for (i) the use of digital laser means, (ii) present phthalocyanine pigment and (iii) present in-situ development step done on a printing press using lithographic fountain solution-covered dampening rollers.

Yamaoka does not teach the use of a digital laser. Fan et al teaches (col.1, lines 44-59) that by using digital laser, one can make corrections easily and quickly and also can save storage space and thus reduce cost. Therefore, it would have been obvious to one skilled in the art to use a digital laser in Yamaoka in order to obtain easy corrections and save storage space and reduce cost. Thus, Yamaoka in view of Fan would render obvious present digital laser.

Yamaoka teaches (col.7, lines 5-15) that his colorant comprises an organic or inorganic dyeing pigment. Phthalocyanine pigment is a conventionally used organic pigment, as evidenced by Sulzberg, col.2, lines 39-43. Since Yamaoka does not give specific names for his organic or inorganic dyeing pigment, it would have been obvious to one of ordinary skill in the art to use conventionally used organic pigment such as phthalocyanine pigment (which is an infrared-absorbing pigment as well) in Yamaoka as a dyeing pigment with a reasonable expectation of obtaining a photopolymerizable composition having a high sensitivity to visible and near infrared light. Therefore, Yamaoka in view of Sulzberg would render obvious present phthalocyanine pigment.

Yamaoka does not teach that his development step is done on-press. Fitzgerald et al teaches on-press development by the action of fountain solution and lithographic

ink, which are deposited onto dampening rollers and inking rollers, respectively (see col.11, lines 47-67). *Particularly, Fitzgerald's exposed printing plate, after being mounted on a press, comes into contact successively with dampening roller wet by a fountain solution and inking rollers wet by ink (see col.11, lines 51-58).* Thus, Fitzgerald teaches present limitation "action on the imaged ink coating with lithographic fountain solution only covered dampening rollers". Fitzgerald states (col.11, lines 28-46) that in the case of negative-working photoresist based upon photopolymerizable ethylenically unsaturated monomers, conventional wet development *can also be* employed using a diluted alkaline solution. However, Fitzgerald also teaches that the processing of conventional lithographic plates prior to their use on a printing press is time and labor consuming and involves the use of substantial quantities of organic chemicals (col.2, lines 65-67, col.3, lines 1-7). Thus, Fitzgerald teaches that there is considerable attractiveness for innovations that would satisfactorily eliminate or reduce conventional lithography's long-felt dependency upon the conduct of bath development and thereby permit the use of lithographic plates on a printing press immediately after exposure without required intermediary processing. Based on Fitzgerald's teachings, it would have been obvious to one skilled in the art to perform on-press development step in Yamaoka by using successively fountain solution-covered rollers and lithographic ink-covered rollers so as to prevent time and labor consuming conventional development process. Therefore, Yamaoka in view of Fitzgerald render obvious present in-situ development step done on a printing press using lithographic fountain solution only covered dampening rollers.

Therefore, Yamaoka in view of Fan, Sulzberg and Fitzgerald would render obvious present inventions of claims 1, 2, 4, 6-12, 14-16 and 24.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Fan et al (5,654,125), Sulzberg (4,173,554) and Fitzgerald et al (5,607,816) as applied to claim 1 above, and further in view of Reichel (5,492,059).

Yamaoka in view of Fan, Sulzberg and Fitzgerald is discussed above in Paragraph 3. Yamaoka does not teach present sleeve or cylinder as his support material. However, as evidenced by Reichel (col.1, lines 15-43), sleeve-shaped printing forms are known in the art to be advantageous as they can easily be mounted onto a form cylinder. It is the Examiner's position that it would have been obvious to one of ordinary skill in the art to provide Yamaoka's aluminum base material in a sleeve shape so that it can be readily mounted on the form cylinder. Therefore, Yamaoka in view of Fan, Sulzberg and Fitzgerald and further in view of Reichel would render obvious present invention of claim 5.

5. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Fan et al (5,654,125), Sulzberg (4,173,554) and Fitzgerald et al (5,607,816) as applied to claim 1 above, and further in view of Mattor (3,847,614).

Yamaoka in view of Fan, Sulzberg and Fitzgerald is discussed above in Paragraph 3. Yamaoka does not state that his photosensitive composition is coated to the base at a predetermined thickness. However, as evidenced by Mattor, col.1, lines 37-41, it is known in the art that in general, the thicker the layer of a photosensitive

material, the greater the run length of a printing plate. Based on Mattor's teaching, it would have been obvious to one of ordinary skill in the art to apply a certain thickness (which is predetermined) of the photosensitive composition in Yamaoka according to a desired (or predetermined) run length of the printing plate. Also, it is the Examiner's position that present means and present steps of claims 17 and 18 would also have been obvious to one of ordinary skill in the art at the time the invention was made because it has been held that broadly providing a mechanical or automatic means to replace a manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 193. Therefore, Yamaoka in view of Fan, Sulzberg and Fitzgerald and further in view of Mattor would render obvious present inventions of claims 17-19.

6. Claims 37-41, 44, 45, 50, 53, 54, 56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Fan et al (5,654,125) and Fitzgerald et al (5,607,816).

Yamaoka teaches a photopolymerizable composition having a high sensitivity to visible and *near infrared light* at a wavelength of 600 nm or more (col.1, lines 17-21). The photopolymerizable composition comprises an addition-polymerizable compound ,which has at least one ethylenically unsaturated double bond (*present reactive diluent*), a radical generating agent and squarylium compound (*present infrared-absorbing dye*). See col.4, lines 50-55. Yamaoka also teaches (col.7, lines 5-15, col.12, lines 66-67, col.13, line 1) that his composition can also contain a binder polymer such as poly(meth)acrylic esters (*present acrylate resin*) as well as a colorant (a dyeing

pigment). Yamaoka states (col.14, lines 18-20, lines 34-40) that his photopolymerizable composition can be used for making *printing plates* and that his composition is coated onto a base such as an aluminum sheet which surface is treated by graining and anodic oxidation processing (thus, Yamaoka teaches *present lithographic support having a hydrophilic surface*). The coated layer is then is subjected to irradiation of light, and the irradiation source includes *visible and near infrared lasers* (col.14, lines 28-33 and lines 45-47). Then the unexposed portions of the photosensitive sample are removed with a developer (such as *aqueous solutions* of an organic alkali chemicals) to provide a printing plate (col.14, lines 32-33, lines 48-49, lines 54-55).

Yamaoka does not teach the use of a digital laser. Fan et al teaches (col.1, lines 44-59) that by using digital laser, one can make corrections easily and quickly and also can save storage space and thus reduce cost. Therefore, it would have been obvious to one skilled in the art to use a digital laser in Yamaoka in order to obtain easy corrections and save storage space and reduce cost. Thus, Yamaoka in view of Fan would render obvious present digital laser.

Yamaoka does not explicitly state that his development step is done on-press. Fitzgerald et al teaches on-press development by the action of fountain solution and lithographic ink, which are deposited onto dampening rollers and inking rollers, respectively (see col.11, lines 47-67). *Particularly, Fitzgerald's exposed printing plate, after being mounted on a press, comes into contact successively with dampening rollers wet by a fountain solution and inking rollers wet by ink (see col.11, lines 51-56).* The fountain solution on the dampening rollers acts on the non-printing areas of the plate to

remove the non-exposed areas and the ink on the inking rollers acts on the image areas to be subsequently transferred to a blanket cylinder and then to a receiving medium (e.g., paper). Thus, Fitzgerald teaches present limitation "acting on the imaged coating with only a lithographic fountain solution to remove the unexposed areas of the coating" since in Fitzgerald only the fountain solution on the dampening rollers is acting to remove the non-exposed areas (and the ink on the inking rollers is being used for inking purpose). Fitzgerald also states (col.11, lines 28-46) that in the case of negative-working photoresist based upon photopolymerizable ethylenically unsaturated monomers, conventional wet development can be employed using a diluted alkaline solution. However, Fitzgerald also teaches that the processing of conventional lithographic plates prior to their use on a printing press is time and labor consuming and involves the use of substantial quantities of organic chemicals (col.2, lines 65-67, col.3, lines 1-7). Thus, Fitzgerald teaches that there is considerable attractiveness for innovations that would satisfactorily eliminate or reduce conventional lithography's long-felt dependency upon the conduct of bath development and thereby permit the use of lithographic plates on a printing press immediately after exposure without required intermediary processing. Based on Fitzgerald's teachings, it would have been obvious to one skilled in the art to perform on-press development step in Yamaoka by using successively fountain solution-covered rollers and lithographic ink-covered rollers so as to prevent time and labor consuming conventional development process. Therefore, Yamaoka in view of Fitzgerald render obvious present in-situ development step done on

a printing press using lithographic fountain solution to remove the unexposed areas of the coating.

Therefore, Yamaoka in view of Fan and Fitzgerald would render obvious present inventions of claims 37-41, 44, 45, 50, 53, 54, 56 and 58 (it is the Examiner's position that Yamaoka's composition which contains colorants would inherently be capable of being a printing ink as presently recited in claim 58).

7. Claims 42, 43, and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Fan et al (5,654,125) and Fitzgerald et al (5,607,816) as applied to claim 37 above, and further in view of Sulzberg (4,173,554).

Yamaoka in view of Fan and Fitzgerald is discussed above in Paragraph 9 (Yamaoka also teaches (col.7, lines 5-59, col.8, lines 1-37) the use of present reactive diluent). As discussed above, Yamaoka teaches (col.7, lines 5-15) that his composition can contain a colorant comprising an organic or inorganic dyeing pigment. Carbon black or phthalocyanine pigments are conventionally used inorganic or organic pigments, as evidenced by Sulzberg, col.2, and lines 39-43. Since Yamaoka does not give specific names for his organic or inorganic dyeing pigment, it would have been obvious to one of ordinary skill in the art to use conventionally used inorganic or organic pigment such as carbon black or phthalocyanine pigment (both of which are infrared-absorbing pigments as well) in Yamaoka as a dyeing pigment with a reasonable expectation of obtaining a photopolymerizable composition having a high sensitivity to visible and near infrared light. Therefore, Yamaoka in view of Fan and Fitzgerald and

further in view of Sulzberg would render obvious present inventions of claims 42, 43, and 46-49.

8. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Fan et al (5,654,125) and Fitzgerald et al (5,607,816) as applied to claim 37 above, and further in view of Mattor (3,847,614).

Yamaoka in view of Fan and Fitzgerald is discussed above in Paragraph 9. Yamaoka does not state that his photosensitive composition is coated to the base at a predetermined thickness. However, as evidenced by Mattor, col.1, lines 37-41, it is known in the art that in general, the thicker the layer of a photosensitive material, the greater the run length of a printing plate. Based on Mattor's teaching, it would have been obvious to one of ordinary skill in the art to apply a certain thickness (which is predetermined) of the photosensitive composition in Yamaoka in order to provide a satisfactory run length of the printing plate. Therefore, Yamaoka in view of Fan, Fitzgerald and further in view of Mattor would render obvious present invention of claim 51.

9. Claims 59-61 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Mattor (3,847,614), Fan et al (5,654,125) and Fitzgerald et al (5,607,816).

Yamaoka teaches a photopolymerizable composition having a high sensitivity to *visible* and *near infrared light* at a wavelength of *600 nm or more* (col.1, lines 17-21). The photopolymerizable composition comprises (see col.4, lines 50-55), an addition-polymerizable compound ,which has at least one ethylenically unsaturated double bond,

a radical generating agent and squarylium compound (*present infrared-absorbing dye*). According to col.7, lines 17-25, Yamaoka's addition-polymerizable compound can either be a monomer (such as esters of unsaturated carboxylic acid and an aliphatic polyhydroxy compound as listed in col.7, lines 38-54) or a polymer having an ethylenically unsaturated double bond on the main or side chain (such as polymers obtained by a polymeric reaction of a polyvinyl alcohol, an epoxy resin, a phenoxy resin or the like with an unsaturated carboxylic acid – see col.8, lines 31-37) so that upon irradiation of an active ray to the photopolymerizable composition, the ethylenical compound cures due to addition-polymerization by the action of the radical-producing agent and the photodecomposition product of the squarylium compound. Thus, Yamaoka teaches present radiation sensitive resin. Yamaoka also teaches (col.7, lines 5-15, col.12, lines 66-67, col.13, line 1) that his composition can also contain a binder polymer such as poly(meth)acrylic esters as well as a colorant (a dyeing pigment). Yamaoka states (col.14, lines 18-20, lines 34-40) that his photopolymerizable composition can be used for making *printing plates* and that his composition is coated onto a base such as an aluminum sheet which surface is treated by graining and anodic oxidation processing (thus, Yamaoka teaches *present lithographic support having a hydrophilic surface*). The coated layer is then is subjected to irradiation of light, and the irradiation source includes *visible and near infrared lasers* (col.14, lines 28-33 and lines 45-47). Then the unexposed portions of the photosensitive sample are removed with a developer (such as *aqueous solutions* of an organic alkali chemicals) to provide a printing plate (col.14, lines 32-33, lines 48-49, lines 54-55).

Therefore, Yamaoka teaches present invention of claim 1 (it is the Examiner's position that Yamaoka's photopolymerizable composition containing *colorant* compound teaches present radiation sensitive ink) except for (i) the step of applying the composition to a lithographic support at a predetermined thickness, (ii) the use of digital laser means and (ii) present in-situ development step done on a printing press using lithographic fountain solution-covered dampening rollers.

Yamaoka does not state that his photosensitive composition is coated to the base at a predetermined thickness. However, as evidenced by Mattor, col.1, lines 37-41, it is known in the art that in general, the thicker the layer of a photosensitive material, the greater the run length of a printing plate. Based on Mattor's teaching, it would have been obvious to one of ordinary skill in the art to apply a certain thickness (which is predetermined) of the photosensitive composition in Yamaoka in order to provide a satisfactory run length of the printing plate. Therefore, Yamaoka in view of Mattor would render obvious present step of applying the composition to a support at a predetermined thickness.

Yamaoka does not teach the use of a digital laser. Fan et al teaches (col.1, lines 44-59) that by using digital laser, one can make corrections easily and quickly and also can save storage space and thus reduce cost. Therefore, it would have been obvious to one skilled in the art to use a digital laser in Yamaoka in order to obtain easy corrections and save storage space and reduce cost. Thus, Yamaoka in view of Fan would render obvious present digital laser.

Yamaoka does not explicitly state that his development step is done on-press. Fitzgerald et al teaches on-press development by the action of fountain solution and lithographic ink, which are deposited onto dampening rollers and inking rollers, respectively (see col.11, lines 47-67). *Particularly, Fitzgerald's exposed printing plate, after being mounted on a press, comes into contact successively with dampening rollers wet by a fountain solution and inking rollers wet by ink (see col.11, lines 51-56).* The fountain solution on the dampening rollers acts on the non-printing areas of the plate to remove the non-exposed areas and the ink on the inking rollers acts on the image areas to be subsequently transferred to a blanket cylinder and then to a receiving medium (e.g., paper). Thus, Fitzgerald teaches present limitation "acting on the imaged coating with only a lithographic fountain solution to remove the unexposed areas of the coating" since in Fitzgerald only the fountain solution on the dampening rollers is acting to remove the non-exposed areas (and the ink on the inking rollers is being used for inking purpose). Fitzgerald also states (col.11, lines 28-46) that in the case of negative-working photoresist based upon photopolymerizable ethylenically unsaturated monomers, conventional wet development can be employed using a diluted alkaline solution. However, Fitzgerald also teaches that the processing of conventional lithographic plates prior to their use on a printing press is time and labor consuming and involves the use of substantial quantities of organic chemicals (col.2, lines 65-67, col.3, lines 1-7). Thus, Fitzgerald teaches that there is considerable attractiveness for innovations that would satisfactorily eliminate or reduce conventional lithography's long-felt dependency upon the conduct of bath development and thereby permit the use of

lithographic plates on a printing press immediately after exposure without required intermediary processing. Based on Fitzgerald's teachings, it would have been obvious to one skilled in the art to perform on-press development step in Yamaoka using fountain solution and lithographic ink, which are deposited onto dampening rollers and inking rollers respectively, so as to prevent time and labor consuming conventional development process. Therefore, Yamaoka in view of Fitzgerald render obvious present in-situ development step done on a printing press using lithographic fountain solution to remove the unexposed areas of the coating.

Therefore, Yamaoka in view of Mattor, Fan and Fitzgerald would render obvious present inventions of claims 59-61 and 63 (since Yamaoka states that his composition is used in making printing plates, it is the Examiner's position that present steps (e) and (f) of claim 59 are impliedly taught by Yamaoka).

10. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka et al (5,756,258) in view of Mattor (3,847,614), Fan et al (5,654,125) and Fitzgerald et al (5,607,816) as applied to claim 59 above, and further in view of Nussel et al (5,317,970).

Yamaoka et al in view of Mattor, Fan and Fitzgerald is discussed above in Paragraph 12. Yamaoka does not explicitly state that the image is removed from Yamaoka's base after a print run has finished. However, as evidenced by Nussel, col.1, lines 15-25, a method of regenerating imaged printing plates, so that, after a prior imaging, they can be erased and re-used and re-imaged. It would have been obvious to one skilled in the art to regenerate Yamaoka's imaged printing plate by erasing the

image and re-using the plate so as to save the cost. Therefore, Yamaoka in view of Mattor, Fan and Fitzgerald and further in view of Nussel would render obvious present invention of claim 65.

Allowable Subject Matter

11. Claims 13, 20-23 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the cited prior arts teaches or suggests present limitation that the same radiation sensitive ink is used in the coating on the hydrophilic support as is used in the printing.

12. Claims 25-35 are allowed. None of the cited prior arts teaches or suggests present limitation that the same radiation sensitive ink is used in the coating on the hydrophilic support as is used in the printing.

Response to Arguments

13. Applicants argue that Fan fails to teach the use of digital imaging of a negative-working lithographic printing form since Fan's printing form is laser-ablated to provide a flexographic printing plate. Applicants thus argue that Yamaoka (drawn to a negative image) cannot be combined with Fan (drawn to a positive image). However, Fan was being cited by the Examiner merely to show that it is already known in the art to use a digital laser for obtaining advantages such as easy and quick corrections, saved storage space and reduced cost. Besides, Fan itself clearly states that the digitized image could be *either* positive *or* negative (see col.1, lines 51-52).

Applicants argue that Fitzgerald does not suggest direct laser imaging. However, such assertion was never made by the Examiner. Next, applicants argue that Fitzgerald fails to teach using only a fountain solution on the dampening rollers for development. However, as addressed above, Fitzgerald's exposed printing plate, after being mounted on a press, comes into contact successively with dampening rollers wet by a fountain solution and inking rollers wet by ink. The fountain solution on the dampening rollers acts on the non-printing areas of the plate to remove the non-exposed areas, and the ink on the inking rollers acts on the image areas to be subsequently transferred to a blanket cylinder and then to a receiving medium (please note that even in present invention, the oleophilic image is being contacted with a printing ink). Thus, Fitzgerald teaches present limitation "acting on the imaged coating with only a lithographic fountain solution *to remove the unexposed areas of the coating*" since in Fitzgerald only the fountain solution on the dampening rollers is acting to remove the non-exposed areas (and the ink on the inking rollers is being used for inking purpose).

Applicants argue that Yamaoka's examples teach the use of a high molecular weight polymethacrylate (a polymeric binder) which one skilled in the art would recognize as not useful for on-press development and that Fitzgerald suggest that they got around the polymeric binder problem by incorporating non-polymeric plasticizers with or without surfactants. First of all, in Yamaoka, the use of a binder polymer is optional. Also, Yamaoka teaches that his composition can contain plasticizers as well (see col.7, lines 5-16). Applicants further argue that the best that one can say about the combination of Yamaoka and Fitzgerald is that one could speculate that the plasticizers

of Fitzgerald could be used in the chemistry of Yamaoka possibly to achieve on-press developability using fountain solution and printing gink and that one skilled in the art would not find this to be a credible suggestion. Applicants argue that if that combination teaching really could do what is speculated in the Office action, the industry would have been taken by storm long ago with a commercial product containing the combined teachings. Applicants argue that that has not occurred despite the fact that both patens were granted over 10 years ago. However, The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are *not evidence* and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, *solution of a long-felt need*, *inoperability of the prior art*, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See MPEP 716.01 (c).

For the reasons stated above, present rejections still stand.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Lee
January 22, 2008

SIN LEE
PRIMARY EXAMINER